

Application No. 10/611,849
Amendment dated July 30, 2004
Reply to Office Action of May 6, 2004

REMARKS

Claims 33-50 remain pending in this application, though Claims 37-39 and 42-50 have been withdrawn. Claims 33, 35, 36, 40 and 41 have been amended to recite that the solid organic acid component is barbituric acid.

Claims 33-36 and 40-41 stand rejected.

Affirmation of Election

Applicants hereby affirm their election, with traverse, to prosecute herein the claims identified in Group I, Claims 33-36, 40 and 41 (see Action, page 2, paragraph 1). This election of Group I is made without waiving Applicants' right to prosecute the non-elected claims in one or more divisional applications.

Applicants hereby also affirm their election for searching purposes only of the species set forth at page 6, paragraph 10 of the Action.

Section 112 Rejection

Claims 35 and 36 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. Reasons for this rejection are set forth on page 7, paragraph 11 of the Action.

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Applicants have amended these claims to provide ranges of components consistent with the specification, as the Examiner has pointed out. Reconsideration and withdrawal of the Section 112 rejection are therefore requested.

Section 102 Rejection

Claims 33, 34 and 40 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by an English-language abstract of Japanese Patent Document No. JP 4-266922 ("JP '922"). Reasons for this rejection are set forth on page 8, paragraph 12 of the Action.

Claims 33 and 34 stand rejected under 35 U.S.C. § 102(a) as allegedly being anticipated by an English-language abstract of Japanese Patent Document Nos. 3-29352 ("JP '352") or 5-3269 ("JP '269"). Reasons for this rejection are set forth on page 10-11, paragraphs 19-22 of the Action.

Applicants traverse the reasoning supporting the Section 102 rejections.

Applicants address in turn each of the English-language abstracts of the Japanese patent documents.

JP '922 appears to refer to epoxy resin compositions and semicured products thereof, for use as heat resistant adhesives in printed circuit board manufacture. These

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compositions appear to include an imidazole as a hardener dissolved in a solvent by carboxylic acids. Included among those acids, the Examiner appears to have noted salicylic acid, citric acid and fumaric acid.

JP '352 appears to refer to a semiconductor device sealed with a resin composition made from an epoxy resin, a phenolic resin, and a phenolic resin derivative in which hydroxy functionality is located in the ortho positions, such as 3,4,5-trihydroxybenzoic acid.

JP '269 appears to refer to epoxy resin compositions for semiconductor sealants, said to have good heat and fire resistance. The compositions appear to include reducing agents, and oxalic acid or ascorbic acid.

In contrast, as amended Claim 33 is directed to a curable one-part epoxy resin composition. The composition includes

- (a) an epoxy component comprising at least one epoxy compound which has two or more groups per soluble;
- (b) a latent hardener component;
- (c) a thixotropy-conferring component; and
- (d) barbituric acid.

The inventive combination confers an improvement in rheological properties, as so described in the Specification. Barbituric acid is not disclosed, taught or suggested in a

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composition containing the recited components of the documents of record.

It is elementary that in order to anticipate a claim under Section 102, each and every recitation of the claims under examination must be disclosed in a single cited document. Failing such precise and exact disclosure, a Section 102 rejection can not stand.

Simply put, neither JP '922, JP '352 nor JP '269 set forth each and every recitation of Claim 33 as amended.

Accordingly, the Section 102 rejection cannot stand and should no longer be maintained.

Section 103(a) Rejection

Claims 35, 36 and 41 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over JP '922. Reasons for this rejection are set forth on page 8, paragraph 13 of the Action.

Claims 33, 34 and 41 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 5,719,225 (Hirano). Reasons for this rejection are set forth on page 9, paragraph 14 of the Action.

Claims 33-36, 40 and 41 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Japanese Patent Document No. 1-245014 ("JP '014") in view of U.S. Patent No.

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4,546,155 (Hirose). Reasons for this rejection are set forth on pages 9-10, paragraphs 16-18 of the Action.

Claims 35, 36 and 41 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over JP '352 and '269. Reasons for this rejection are set forth on page 11, paragraph 22 of the Action.

Claims 33-36, 40 and 41 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Japanese Patent Document No. 1-29416 ("JP '416") in view of Hirano and JP '014. Reasons for this rejection are set forth on page 11, paragraphs 23 and 24 of the Action.

Applicants traverse the reasoning supporting the Section 103(a) rejections, and address in turn each of the documents cited as Section 103 references.

JP '014 appears to refer to a group epoxy resin composition or potting semiconductors. These compositions include a compound having three hydroxy groups at adjacent positions on an aromatic ring. Among the compounds identified as such polyhydroxy aromatic compounds is 3,4,5-trihydroxy benzoic acid, like JP '352 above.

JP '416 discloses a one pack epoxy resin composition having a hydrazinotriazine curing agent, an imidazole cure accelerator and a filler mixed with a fine silica powder as a thixotropy imparting agent. This composition is said to be highly thixotropic and have excellent shape retention.

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Hirano is directed to and claims a molding resin composition containing, in a resin, a filler comprising a globular powder of which mean particle diameter is not smaller than 0.1 μm and not greater than 1.5 μm (x component), a globular powder of which mean particle diameter is not smaller than 2 μm and not greater than 10 μm (y component) and a globular powder of which mean particle diameter is not smaller than 20 μm and not greater than 70 μm (z component), wherein proportions of the x, y and z components based on the total volume of x, y and z components are not smaller than 10% by volume and not greater than 24% by volume, not smaller than 0.1% by volume and not greater than 30% by volume and not smaller than 57% by volume and not greater than 76% by volume, respectively.

Hirose is directed to and claims a latent curing agent for epoxy resin, characterised in that the latent curing agent is an adduct obtained by reacting (a) a polyfunctional epoxy compound, (b) a compound having at least one OH, NH_2 , NH or SH group together with a tertiary amino group in the molecule, and (c) a carboxylic acid anhydride.

There is no disclosure, teaching or suggestion in the English-language abstract of any of JP '014, JP '416, Hirano or Hirose, whether alone or in combination (assuming combination was proper), to use barbituric acid, let alone in a curable one-part epoxy resin composition.

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As that which is disclosed in the English-language abstracts of JP '014 or JP '416 is different from the composition of either of Hirano or Hirose, there is no reason for the skilled person to look to either of the English-language translation abstracts of the Japanese patent documents when stabilization of the physical properties of a curable one-part epoxy resin composition is sought. Thus, no motivation exists to combine any one or more of the English-language translation abstracts of the Japanese patent documents with Hirano or Hirose.

Any perceived motivation has been achieved through speculation as to what the complete disclosure of the Japanese patent publications read. Thus, the motivation to combine could only have come about through a disturbing or modification of the disclosure of the English-language translation of the abstracts, prohibited under U.S. patent practice, and gleaned through hindsight reconstruction of the claims under examination, likewise prohibited under U.S. patent practice.

Therefore, Applicants submit that the Action has failed to establish a *prima facie* case of obviousness.

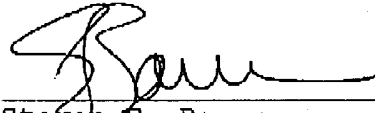
CONCLUSION

Applicants request reconsideration and withdrawal of each of the rejections advanced in the Action, and prompt passage to issue of the subject application.

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Applicants' undersigned attorney may be reached by telephone at (860) 571-5001, by facsimile at (860) 571-5028 or by e-mail at steve.bauman@loctite.com. All correspondence should be directed to the address given below.

Respectfully submitted,



Steven C. Bauman
Attorney for Applicants
Registration No. 33,832

HENKEL CORPORATION
Legal Department
1001 Trout Brook Crossing
Rocky Hill, Connecticut 06067

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